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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,496	10/01/2003	Akiko Onishi	00862.023332.	4228
5514 7590 10/02/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER HUNTSINGER, PETER K				
ART UNIT 2625		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/674,496

**Applicant(s)**

ONISHI, AKIKO

**Examiner**

Peter K. Huntsinger

**Art Unit**

2625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4, 5, 7, 9, 11, 13 and 15-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7, 9, 11, 13 and 15-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/22/08 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 4, 5, 7, 9, 11, 13 and 15-32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 15, 21 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 15, 21 and 27, the limitation "the

entire setting screen has a plurality of setting screens" is not described in the specification. The applicant's specification only describes the entire setting screen in relation to Fig. 6, which shows one setting screen. The applicant's specification also does not provide any description of multiple screens (only the entire setting screen and the partial setting screen).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 15, 21, 25, 27 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 15, 21 and 27 include the limitation "a designation" on line 3. The independent claims also include the limitation "the designation", so it is unclear whether the reference to "a designation" from claims 1, 7, and 13 are the same or distinct from the reference in claims 15, 21, and 27.

8. Claims 25 and 31 recite the limitation "the printer driver" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 4, 7, 9, 11, 13, 16, 18, 20, 22, 24, 26, 28, 30 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Perry '190.

Referring to **claim 1**, Perry '190 discloses a printing control method executed in an information processing apparatus which has a printer driver to generate print data which a printing apparatus can process, said printing control method comprising:

a first displaying step of displaying an entire setting screen to set an entire setting print attribute to be applied to the entire print data (Fig. 5, col. 5, lines 20-30, print job properties can be created that will apply to the entire print job);

a second displaying step of displaying a partial setting screen to set a partial print attribute to be applied to a part of the print data, wherein the partial setting screen is a screen in which the entire print attribute is reflected (Figs. 6A-D, col. 7, lines 18-45, print job exceptions attributes window allows user to enter print job exception attributes); and

a generating step of generating the print data to print a print material in which the entire print attribute and the partial print attribute are reflected, (col. 2, lines 31-40, prints print job that includes print job level properties and print job exception attributes)

wherein the partial setting screen has a designation field to receive a designation of a page as the part of the print data to which the partial print attribute to be applied,

and the entire setting screen does not have the designation (Figs. 6A-D, col. 6, lines, 34-40, print job exceptions attribute window allows a user to specify a page range).

Referring to **claim 4**, Perry '190 discloses a setting step of setting the entire print attribute including paper types, print quality, and color adjustment (col. 4, lines 22-33, properties for an entire print job include paper stock, printer output, and page color).

Referring to **claim 7**, see the rejection of claim 1 above.

Referring to **claim 9**, see the rejection of claim 4 above.

Referring to **claim 11**, Perry '190 discloses a printing system comprising:  
a printing control apparatus for generating data which a printing apparatus can process (printing system 1000 of Fig. 1, col.3, lines 41-46);

a first displaying unit which displays an entire setting screen to set an entire setting print attribute to be applied to the entire print data (user interface of Fig. 5, col. 5, lines 20-30, print job properties can be created that will apply to the entire print job);

a second displaying unit which displays a partial setting screen to set a partial print attribute to be applied to a part of the print data, wherein the partial setting screen is a screen in which the entire print attribute is reflected (user interface of Figs. 6A-D, col. 7, lines 18-45, print job exceptions attributes window allows user to enter print job exception attributes); and

a generating unit which generates the print data to print a print material in which the entire print attribute and the partial print attribute are reflected, (printing system 1000 of Fig. 1, col.3, lines 41-46) (col. 2, lines 31-40, prints print job that includes print job level properties and print job exception attributes)

wherein the partial setting screen has a designation field to receive a designation of a page as the part of the print data to which the partial print attribute to be applied, and the entire setting screen does not have the designation (Figs. 6A-D, col. 6, lines, 34-40, print job exceptions attribute window allows a user to specify a page range).

Referring to **claim 13**, see the rejection of claim 1 above.

Referring to **claim 16**, Perry '190 discloses when the partial print attribute is not set, print data to print a printed material is generated in which the entire print attribute is reflected in all pages of the print data, and

when the partial print attribute is set, print data to print a printed material is generated in which (i) both the entire print attribute and the partial print attribute are reflected in a designated page designated using the partial setting screen, and (ii) the entire print attribute is reflected in pages other than the designated page (col. 2, lines 31-40, prints print job that includes print job level properties and print job exception attributes).

Referring to **claim 18**, Perry '190 discloses a printing control method to be executed in an information processing apparatus to set a print attribute to print a document, said printing control method comprising:

a first displaying step of displaying a first setting screen to set a first print attribute to be applied to the document (Fig. 5, col. 5, lines 20-30, print job properties can be created that will apply to the entire print job);

a second displaying step of displaying a second setting screen to set a second print attribute to be applied to a page designated by user, wherein the second print

attribute is different from the first print attribute (Figs. 6A-D, col. 7, lines 18-45, print job exceptions attributes window allows user to enter print job exception attributes); and

a generating step of generating print data to print a print material in which the first print attribute is reflected for the document when the first print attribute is set, whereas generating print data to print a print material in which the second print attribute is reflected for the designated page and the first print attribute is reflected for the page different from the designated page when the first print attribute and the second print attribute are set (col. 2, lines 31-40, prints print job that includes print job level properties and print job exception attributes),

wherein the second setting screen has a field to designate a page to which the second print attribute is applied (Figs. 6A-D, col. 6, lines, 34-40, print job exceptions attribute window allows a user to specify a page range).

Referring to **claim 20**, Perry '190 discloses wherein the first print attribute and the second print attribute include a plurality of setting values (col. 4, lines 22-42, lists settings of print job property level properties and print job exception attributes)

Referring to **claim 22**, see the rejection of claim 16 above.

Referring to **claim 24**, Perry '190 discloses an information processing apparatus to set a print attribute to print a document, said information processing apparatus comprising:

a first displaying unit which displays a first setting screen to set a first print attribute to be applied to the document (user interface of Fig. 5, col. 5, lines 20-30, print job properties can be created that will apply to the entire print job);



a second displaying unit which displays a second setting screen to set a second print attribute to be applied to a page designated by user, wherein the second print attribute is different from the first print attribute (user interface of Figs. 6A-D, col. 7, lines 18-45, print job exceptions attributes window allows user to enter print job exception attributes); and

a generating unit which generates print data to print a print material in which the first print attribute is reflected for the document when the first print attribute is set, whereas generating print data to print a print material in which the second print attribute is reflected for the designated page and the first print attribute is reflected for the page different from the designated page when the first print attribute and the second print attribute are set (printing system 1000 of Fig. 1, col.3, lines 41-46) (col. 2, lines 31-40, prints print job that includes print job level properties and print job exception attributes),

wherein the second setting screen has a field to designate a page to which the second print attribute is applied (Figs. 6A-D, col. 6, lines, 34-40, print job exceptions attribute window allows a user to specify a page range).

Referring to **claim 26**, see the rejection of claim 20 above.

Referring to **claim 28**, see the rejection of claim 16 above.

Referring to **claim 30**, see the rejection of claim 18 above.

Referring to **claim 32**, see the rejection of claim 20 above.

11. Claims 5, 17, 19, 23, 25, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry '190 as applied to claims 1, 7, 13, 18, 24 and 30 above, and further in view of well known prior art.

Referring to **claim 5**, Perry '190 discloses print data, but does not disclose expressly wherein the print data is bitmap data.

Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to output print data as a bitmap (See MPEP 2144.03). The motivation for doing so would have been to utilize a conventional print job format that does not require format conversion at the printer. Therefore, it would have been obvious to combine well known prior art with Perry '190 to obtain the invention as specified in claim 5.

Referring to **claim 17**, Perry '190 discloses the entire setting screen and the partial setting screen but does not disclose expressly wherein the screens are provided by the printer driver.

Official Notice is taken that it is well known and obvious to a person of ordinary skill in the art to provide a print user interface via a printer driver (See MPEP 2144.03). The motivation for doing so would have been to utilize the same program for customizing and formatting print data, thus reducing program conflicts. Therefore, it would have been obvious to combine well known prior art with Perry '190 to obtain the invention as specified in claim 17.

Referring to **claim 19**, see the rejection of claim 17 above.

Referring to **claim 23**, see the rejection of claim 17 above.

Referring to **claim 25**, see the rejection of claim 17 above.

Referring to **claim 29**, see the rejection of claim 17 above.

Referring to **claim 31**, see the rejection of claim 17 above.

12. Claims 15, 21 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry '190 as applied to claims 1, 7 and 13 above, and further in view of lwase '492.

Referring to **claim 15**, Perry '190 discloses wherein the partial setting screen is displayed in response to a designation inputted when one of the plurality of settings screens is displayed (col. 6, lines 34-40, user can create a new exception by using the "add exceptions" button).

Perry '190 does not disclose expressly wherein the entire setting screen has a plurality of setting screens.

lwase '492 discloses a entire setting screen has a plurality of setting screens (Fig. 19, col. 12, lines 41-53, menu has a sort, double-sided print, copy, density saturation, and color balance tabs).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a setting screen with multiple tabs. The motivation for doing so would have been to provide the user with a multitude of print attributes conveniently organized within tabbed screens. Therefore, it would have been obvious to combine lwase '492 with Perry '190 to obtain the invention as specified in claim 15.

Referring to **claim 21**, see the rejection of claim 15 above.

Referring to **claim 27**, see the rejection of claim 15 above.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Peter K. Huntsinger/  
Examiner, Art Unit 2625

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625